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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/252,842	02/19/1999	CHARI STYLLI	AUROBIO.014A	4954

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EXAMINER

SINES, BRIAN J

ART UNIT PAPER NUMBER

1743

DATE MAILED: 10/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/252,842

Applicant(s)

STYLLI ET AL.

Examiner

Brian J. Sines

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/11/2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,6 and 20-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,6 and 20-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 22 is rejected under 35 U.S.C. 102(e) as being anticipated by Davis, Jr. et al.

(U.S. Pat. No. 5,647,724 A). Davis, Jr. et al. teach an apparatus comprising: a plurality of storage locations (22 & 23); a robotic apparatus (12) for transporting substrates or materials; and a chemical storage buffer (e.g., one of the two substrate holders 22 or 23 can perform independently of the other holder; therefore, one substrate holder can temporarily hold one substrate, while the other substrate retrieves another substrate) (see col. 1, lines 18 – 55; col. 2, lines 10 – 65; figure 4A).

It should be noted that this claim is directed to an apparatus. Therefore, it is the structural limitations of the apparatus, as recited in the claim, which are considered in determining the patentability of the apparatus. The recitation of various process or use limitations not associated or evidenced by structural limitations not defined over the prior art apparatus, are accorded no patentable weight to an apparatus. For example, these claims recite how the apparatus is to be operated, such as in retrieving or holding materials at different times, which imply an intended use, which do not impart any limitations to define the structure of the apparatus being claimed. Process limitations do not add patentability to a structure, which is not distinguished from the

Art Unit: 1743

prior art. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967); and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The Courts have held that it is well settled that the recitation of a new intended use, for an old product, does not make a claim to that old product patentable. See *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). The Courts have held that apparatus claims must be structurally distinguishable from the prior art in terms of structure, not function. See *In re Danley*, 120 USPQ 528, 531 (CCPA 1959); and *Hewlett-Packard Co. V. Bausch and Lomb, Inc.*, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). The Courts have held that the manner of operating an apparatus does not differentiate an apparatus claim from the prior art, if the prior art apparatus teaches all of the structural limitations of the claim. See *Ex Parte Masham*, 2 USPQ2d 1647 (BPAI 1987) (see MPEP § 2114).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

Art Unit: 1743

3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Davis, Jr. et al. Davis, Jr. et al. do not specifically teach the incorporation of 2,000 storage locations for multi-well plates. Davis, Jr. et al. do teach that the apparatus is to be used with multiple processing chambers (see col. 1, lines 39 – 55; col. 4, lines 29 – 67; col.5, lines 1 – 3). Davis, Jr. et al. do recognize the suitability of utilizing the disclosed robotic apparatus for the intended purpose of speeding up processing throughput (see col. 4, lines 60 – 67) (see MPEP § 2144.07).

Furthermore, the Courts have held that the mere duplication of parts, without any new or unexpected result, is within the ambit of one of ordinary skill in the art. see *In re Harza*, 124 USPQ 378 (CCPA 1960). Therefore, it would have been obvious to one of ordinary skill in the art to incorporate more storage locations within the apparatus, as taught by Davis, Jr. et al., in order to increase the through-put processing capability of the apparatus.

Claims 1 – 3, 6, 20, 21 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Armes et al. (U.S. Pat. No. 4,676,951). Armes et al. teach an apparatus comprising: a chemical library comprising storage locations (18); a computer controlled retriever (13); a transport path provided by the movement of the retriever (13); a plurality of automated liquid handling devices (14 & 15); and a user interface (12 & 16) (see col. 6, lines 1 – 68 & col. 7, lines 1 – 56). Armes et al. do not specifically teach the incorporation of at least 100,000 wells within the tray system. Armes et al. do recognize the suitability of the disclosed apparatus for processing a multitude of samples using multiple trays (18) comprising a plurality of wells (19) (see col. 7, lines 7 – 68; col. 8, lines 1 – 49) (see MPEP § 2144.07). Furthermore,

Art Unit: 1743

the Courts have held that the mere duplication of parts, without any new or unexpected result, is within the ambit of one of ordinary skill in the art. see *In re Harza*, 124 USPQ 378 (CCPA 1960). Therefore, it would have been obvious to one of ordinary skill in the art to incorporate more wells within the apparatus, as taught by Armes et al., in order to increase the through-put processing capability of the apparatus. Regarding claim 2, the transport path is the path of movement contained within housing (H), which is traversed by the retriever (12) during operation. Regarding claim 6, the retriever may function to hold or store plates during sample analysis or apparatus operation, thereby acting as a buffer (see col. 10, lines 30 – 48). The Courts have held that apparatus claims must be structurally distinguishable from the prior art in terms of structure, not function. See *In re Danley*, 120 USPQ 528, 531 (CCPA 1959); and *Hewlett-Packard Co. V. Bausch and Lomb, Inc.*, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). The Courts have held that the manner of operating an apparatus does not differentiate an apparatus claim from the prior art, if the prior art apparatus teaches all of the structural limitations of the claim. See *Ex Parte Masham*, 2 USPQ2d 1647 (BPAI 1987) (see MPEP § 2114).

Conclusion


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. McCulloch et al. teach a fluid assay apparatus utilizing a robotic moving system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Sines whose telephone number is (703) 305-0401. The examiner can normally be reached on Monday - Friday (11:30 AM - 8 PM EST).

Art Unit: 1743

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (703) 308-4037. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


Jill Warden
Supervisory Patent Examiner
Technology Center 1700